

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KENNETH W. RAKE, ORVIL L. JUDGE  
and DONALD M. EARHART

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Appeal No. 97-2884  
Application 07/824,855<sup>1</sup>

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HEARD: MAY 4, 1998

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Before MEISTER, McQUADE and CRAWFORD, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 58 through 61. Claims 39 through 41, 44 through 57 and 62, the only other claims pending in the application, stand withdrawn

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<sup>1</sup> Application for patent filed January 24, 1992.

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from consideration pursuant to 37 CFR § 1.142(b).

The subject matter on appeal relates to a spring-powered drug infusion device. A copy of the appealed claims appears in the appendix to the appellants' brief (Paper No. 27).

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Cohen 1974	3,847,304	Nov. 12,
Malacheski et al. (Malacheski) 1978	4,077,544	Mar. 7,
Negaty-Hindi et al. (Negaty-Hindi) 12, 1988	4,756,450	Jul.
Gangemi 1990	4,966,585	Oct. 30,

The appealed claims stand rejected as follows:

a) claims 58 through 61 under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to provide an adequate written description of the invention;

b) claims 58 through 61 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention;

c) claims 58, 60 and 61 under 35 U.S.C. § 102(b) as being

anticipated by Cohen;

d) claims 58, 60 and 61 under 35 U.S.C. § 103 as being unpatentable over Cohen or Malacheski in view of Gangemi; and

e) claims 58 and 59 under 35 U.S.C. § 103 as being unpatentable over Negaty-Hindi in view of Cohen, Malacheski and Gangemi.<sup>2</sup>

We shall not sustain any of these rejections.

The 35 U.S.C. § 112, first paragraph, rejection is based on the examiner's determination that the appellants' specification does not provide an enabling disclosure of the infusion apparatus embodiment depicted in Figures 8 through 10 (see the objection to the specification set forth in Paper No. 10; and pages 4 and 5 in the answer). The examiner, however, has not advanced any cogent reasoning as to why the appellants' disclosure of this relatively simple and straightforward embodiment would not have enabled a person of ordinary skill in the art to make and use the same without

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<sup>2</sup> The examiner's answer (Paper No. 28) improperly refers to a plurality of prior Office actions to explain the appealed rejections. As stated in Section 1208 of the Manual of Patent Examining Procedure, "[a]n examiner's answer should not refer, either directly or indirectly, to more than one prior Office action for the statement of the grounds of rejection."

undue experimentation. Moreover, the appealed claims, which recite an infusion apparatus comprising, inter alia, a platen having a non-planar bottom surface configuration which is complementary to the bottom contour of the second shell or chamber, do not read on the embodiment shown in Figures 8 through 10 which does not have such a platen. Rather, the appealed claims read on the infusion device embodiment shown in Figures 1 through 6 which does have such a platen and whose disclosure has not been questioned by the examiner.<sup>3</sup> Thus, even if the appellants' specification did fail to provide an enabling disclosure of the embodiment shown in Figures 8 through 10, this circumstance would not give rise to an enablement rejection of the appealed claims which are not directed to such embodiment.

The 35 U.S.C. § 112, second paragraph, rejection rests on the examiner's determination that claims 58 through 61 are indefinite because they do not recite a positive structural connection between the fluid delivery bag and the other

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<sup>3</sup> The statement on page 8 in the appellants' brief that claims 58 through 61 read on both embodiments finds no support in the specification.

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recited elements of the claimed infusion apparatus (see pages 2 and 3 in Paper No. 23, and page 5 in the answer). Be this as it may, the claims do contain functional language which sets forth the relationship between the fluid delivery bag and the other recited elements with a reasonable degree of precision and particularity. In this light, it is not apparent, nor has the examiner specifically explained, why the absence of language reciting a positive structural connection between these elements renders the appealed claims indefinite.

The 35 U.S.C. § 102(b) rejection of claims 58, 60 and 61 as being anticipated by Cohen is unsound because Cohen does not meet the limitations in these claims requiring the platen to have a non-planar bottom surface configuration which is complementary to the bottom contour of the second shell or chamber. In this regard, anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Cohen discloses a fluid dispenser having a platen in the form of rigid flat plate 42 and a second shell or chamber in the form of elongate body portion 12. Body portion 12 defines a "bottom" contour at the end portion thereof which supports protruding needle 20. The examiner's finding that Cohen's plate 42 has a "non-planar" bottom surface configuration which is "complementary" to the bottom contour of the body portion 12 (see pages 3 and 4 in Paper No. 23, and pages 5 and 6 in the answer) is inconsistent with (1) Cohen's teaching that plate 42 is "flat" and (2) a reasonable interpretation of the word "complementary."

As for the 35 U.S.C. § 103 rejection of claims 58, 60 and 61 as being unpatentable over Cohen or Malacheski in view of Gangemi, neither of the primary references, Cohen or Malacheski, meets the limitations in these claims requiring the platen to have a non-planar bottom surface configuration which is complementary to the bottom contour of the second shell or chamber. Cohen's deficiencies in this regard are discussed above. Malacheski discloses a fluid dispenser comprising a platen in the form of a flat disc-like piston 41 having a planar bottom surface configuration which clearly is

not complementary to the bottom contour 20 of shell 11. This bottom contour 20 defines an annular pocket 26 for accommodating a fluid bladder 35 as the piston 41 presses the bladder to expel fluid therefrom (see Figure 2; column 2, lines 1 through 27 and 60 through 68; and column 4, lines 45 through 58). The examiner's reliance on Gangemi to cure these shortcomings in Cohen and Malacheski is not well taken.

Gangemi discloses an infusion syringe 10 comprising a piston member 20 and a cylinder bore 11. The nose end 20a of the piston member is tapered and configured to the geometrical shape of the end 12 of the bore to ensure the full discharge of fluid from the bore (see column 3, lines 27 through 29; and column 7, lines 59 through 62). According to the examiner,

[t]o employ a platen, i.e. piston, having a non-planar bottom surface complementary to the bottom contour of the second shell as taught by Gangemi on either the Cohen or Malacheski et al device would have been obvious to one of ordinary skill in the art in view of the recognition that such a feature would be more economically efficient, i.e. effects full discharge, and that economic efficiency is desirable in any device [Paper No. 23, page 5].

Notwithstanding the "full discharge" benefit taught by Gangemi, the modification of the Cohen and Malacheski devices proposed by the examiner would have been problematical given

the protrusion of needle 20 from Cohen's bottom contour and the presence of bladder accommodating pocket 26 in Malacheski's bottom contour. In this light, it is evident that the only motivation for combining Cohen or Malacheski and Gangemi in the manner proposed by the examiner stems from impermissible hindsight knowledge derived from the appellants' own disclosure. In other words, the fair teachings of Cohen or Malacheski and Gangemi would not have suggested the subject matter recited in claims 58, 60 and 61 to one of ordinary skill in the art.

The proposed combination of Negaty-Hindi, Cohen, Malacheski and Gangemi to support the 35 U.S.C. § 103 rejection of claim 58, and claim 59 which depends therefrom, suffers from the same flaw. Negaty-Hindi discloses a carbonated drink dispenser which fails to respond to a number of limitations in claims 58 and 59 including the one in independent claim 58 requiring the platen to have a non-planar bottom surface configuration which is complementary to the bottom contour of the second shell or chamber. In short, the combined teachings of the applied references would not have suggested the modifications of Negaty-Hindi's carbonated drink



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dispenser necessary to arrive at the subject matter recited in  
claims 58 and 59.

In summary and for the above reasons, the decision of the  
examiner to reject claims 58 through 61 is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JOHN P. McQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

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